

Application No.: 10/039957

Case No.: 53325US002

REMARKS

Claim 8 has been amended to include the term "release" before the term "liner" as supported throughout the specification such as at p. 4, lines 2-3. New Claim 27 recites original Claim 8 in independent form including the amendment to Claim 8 just described. New claim 28 recites the combination of Claim 12 and amended Claim 8.

Rejections Under 35 U.S.C. 102

Claims 1, 4, 6-9, 12, 15, 18, 21, 22 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Eigenmann (U.S. Patent No. 4,072, 403).

As the basis of the rejection, the Examiner states that, "The elements (G) are bonded to the web (16'). There is a frangible connection (14') between a plurality of the pavement elements and the carrier web (Figure 7, for example)."

The Applicant submits that reference numeral 16' of Eigenmann is a thin layer of transparent polymeric binder that binds the microspheres to the underlying globule. This polymeric binder is not a carrier web (i.e. a web to carry the pavement elements), but rather a requisite component of the pavement marker. Even if one did take the position that this layer is a carrier web is not selected from paper, a release liner, a screen, a mat, a film or nonwoven web of a water-soluble or water-dispersible polymeric material, and a biodegradable material; as recited in original Claim 8 and Claim 28.

In some preferred embodiments, the carrier web is removable from the pavement elements. Independent claims 1 and 12 have been amended to clarify this point. Support for this amendment is found throughout the specification such as at p. 4, lines 6-10.

Rejections Under 35 U.S.C. 103

Claims 17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eigenmann.

Claims 3, 10, 11, 16, and 19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Eigenmann as applied above, and further in view of Clark et al. (U.S. Patent no 5,853,846)

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In view of the amendments made, this rejection is now moot since the combination of Eigenmann and Clark does not teach all the claim limitations.

The Applicant has responded to all the rejections at hand. A timely allowance is respectfully requested.

Respectfully submitted,

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Date

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